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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,349	04/12/2001	Oliver Gottschalt	A-2794	3798

7590

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EXAMINER

EVANISKO, LESLIE J

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/833,349

Applicant(s)

GOTTSCHALT ET AL.

Examiner

Leslie J. Evanisko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 12-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-11, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of group II, claims 5-11 in Paper No. 10 is acknowledged.
2. Claims 1-4 and 12-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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4. Claim 5-11, 23, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Haijima et al. (US 5,456,175). Haijima et al. teach an imaging machine **27** comprising a magnetic cylinder **30** (including at least one permanent magnet **260** embedded therein) for holding the printing plate during the setting of the image thereon. See Figures 8A, 49, and 60, column 25, lines 15-22, and column 28, lines 1-35 of Haijima et al. in particular.

With respect to claim 6, the sprocket mechanism **30a** on the cylinder **30** can broadly be considered to be a register system for aligning the printing sheet.

With respect to claim 7, note the sheet clasper **258** of Haijima et al.

With respect to claims 9-11, to the extent that applicant has recited any particular structure of the various imaging machines recited, note that Haijima et al. teach an imaging machine which can broadly be considered to be any one of a "plate-exposing," "plate-developing," or "plate-engraving" machine. See column 2, lines 53-54 and the abstract.

With respect to claim 23, note Haijima et al. teach an imaging machine comprising a magnetic cylinder **30** with at least one magnet **260**, a register system **30a**, and at least one clamping device **258** disposed separate from the magnet as recited.

With respect to claim 24, note that Haijima et al. teach an imaging machine comprising a magnetic cylinder **30** for "directly" holding the printing

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plate firmly during the setting of the image thereon, as broadly recited by applicant.

5. Claim 24 is rejected under 35 U.S.C. 102(e) as being anticipated by Montgomery et al. (US 5,947,028). Montgomery et al. teach an imaging machine for setting an image on a printing plate comprising a magnetic cylinder for directly holding the printing plate is well known in the art. Note, in particular, column 1, lines 12-24.

6. Claim 24 is rejected under 35 U.S.C. 102(e) as being anticipated by Ganton (US 6,130,702). Ganton teaches an imaging machine comprising a magnetic cylinder **13** for “directly” holding the printing plate firmly during the setting of an image thereon. See Figures 2a-2d and column 1, lines 48-67 and column 2, line 51-column 3, line 19 in particular. Note that the term “magnetic” is broadly defined by Merriam Webster’s Collegiate Dictionary (Tenth Edition) as “being magnetized or capable of being magnetized”. Since Ganton teaches that “the drum **13** is made of a ferromagnetic material such as cast iron or has steel inserts to allow the magnet **16** to adhere to the drum” (column 3, lines 8-10), the drum can broadly be considered to be magnetic as recited.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganton (US 6,130,702). Ganton teaches an imaging machine comprising a magnetic cylinder **13** for “directly” holding the printing plate firmly during the setting of an image thereon. See Figures 2a-2d and column 1, lines 48-67 and column 2, line 51-column 3, line 19 in particular. Note that the term “magnetic” is broadly defined by Merriam Webster’s Collegiate Dictionary (Tenth Edition) as “being magnetized or capable of being magnetized”. Since Ganton teaches that “the drum **13** is made of a ferromagnetic material such as cast iron or has steel inserts to allow the magnet **16** to adhere to the drum” (column 3, lines 8-10), the drum can broadly be considered to be magnetic as recited.

Furthermore, although Ganton teaches the drum is made of magnetically attractable material which attracts a magnetic clamp 16 (permanent or electromagnetic), it would have been obvious to one of ordinary skill in the art to make the drum include permanent or electromagnetic members and the

clamp to be made of a magnetically attractable material, as it would require simply the obvious reversal of parts to provide securing of a printing plate on the imaging cylinder.

With respect to claim 6, note the teaching of a register system in column 2, lines 57-67 of Ganton.

With respect to claims 7 and 23, note the magnetic cylinder of Ganton includes at least one clamping device **16**, and with the obvious reversal of the magnetic elements and cylinder as set forth above, the clamping device would be disposed separately from the magnetic cylinder for firmly clamping the printing plate as broadly recited.

With respect to claims 9-11, to the extent that applicant has recited any particular structure of the various imaging machines recited, note that Ganton teaches an imaging machine which can broadly be considered to be any one of a "plate-exposing," "plate-developing," or "plate-engraving" machine. See column 2, lines 53-54 and the abstract.

### ***Response to Arguments***

9. Applicant's arguments filed November 19, 2002 have been fully considered but they are not persuasive of any error in the above rejections.

In particular, applicant argues that the features of the claims are not shown in either of Ganton or Haijima et al. since neither Ganton or Haijima teach a printing plate having a magnetically attractable material which is

directly held in place by magnetic force between the magnetic cylinder and magnetic plate. The Examiner disagrees with this argument. In particular, the claims are directed to an imaging machine per se and not the combination of the imaging machine and the printing plate. In particular, the claims recite an imaging machine for use with a magnetic printing plate, the imaging machine comprising a magnetic cylinder. The printing plate is merely part of the intended use statement and is not a positively required structural element of the claim. Therefore, the type of plate that is used with the imaging machine does not affect the structure of the imaging machine and cylinder and is of no patentable significance. The cylinder of the imaging machine of Ganton and Haijima et al. are capable of being used with a magnetic printing plate and therefore, Ganton and Haijima et al. teach the structure of the imaging machine as broadly recited.

Additionally, applicant argues that neither Ganton nor Haijima et al. teach an arrangement for “directly” holding the printing plate on the cylinder since each reference uses an indirect clamping arrangement for holding the plate on the cylinder. The Examiner disagrees with this argument for several reasons. Firstly, as discussed above, the plate is not part of the claimed combination. Furthermore, if a magnetic plate was used with the cylinder of either of Ganton or Haijima et al., the cylinder would function to directly hold the plate as recited. Additionally, each reference can be considered to meet that claim limitation in that the plate is held in direct contact with the cylinder



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surface and therefore the cylinder can be considered to be "directly holding" the plate.

In view of these reasons, the Examiner is not persuaded of any error in the above rejections.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone


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number is **(703) 308-0786**. The examiner can normally be reached on M-Th  
7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the  
examiner's supervisor, Andrew H. Hirshfeld can be reached on (703) 305-6619.  
The fax phone numbers for the organization where this application or  
proceeding is assigned are (703) 308-7722 for regular communications and  
(703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this  
application or proceeding should be directed to the receptionist whose  
telephone number is (703) 308-0956.

  
Leslie J. Evanisko  
Primary Examiner  
Art Unit 2854

  
lje  
January 24, 2003